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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/030,766  
Filing Date: October 22, 2001  
Appellant(s): CHEAH ET AL.

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Paul P. Kiel  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 04/27/2009 appealing from the Office action mailed 10/31/2008.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 1-7, 9, and 10** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The independent claims 1, 4, 6, and 10 appear to seek protection for new matter. Specifically, they seek protection for "using a security code... to generate a decryption program", wherein the generating step was not described. The generating step is thought to convey to one of ordinary skill in the art broader concepts than merely decrypting, whereas the specification has only disclosed "using the security code [to decrypt a decryption program]" (see figure 3, step 118 and p. 8, lines 9-10). The dependent claims 2, 3, 5, 7, and 9 are rejected because they depend from the independent claims incorporating new matter.

**Claims 1-7, 9, and 10** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is amended to read "using a security code... to generate a decryption program", wherein the specification does not teach generation of a decryption program. The term generation appears to be broader than the disclosed "decryption of a decryption program" (see figure 3, step 118 and p. 8, lines 9-10).

Claims 4, 6, and 10 are amended similarly to claim 1 and are rejected for the same reasons.

Claims 2, 3, 5, 7, and 9 are rejected under 35 USC 112, because they depend from claims 1, 4, and/or 6.

**Claims 1-7 and 9-10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaganas, Cho et al. (USPN 7,324,974), and Truong (hereinafter Kaganas, Cho, and Truong, respectively).

Regarding **claim 1**, in a handheld audio playback device, Kaganas teaches a method for playing back an audio data file, the audio data file being encoded in accordance with a selected one of a plurality of encoding formats, the method comprising the steps of:

*identifying a selected audio data file in response to a user input (column 2, lines 10-18, column 5, lines 4-14, and figure 1);*

*identifying a decoder file associated with the selected audio data file, the decoder file comprising a decoding program to control a decoding function of a digital signal processor (column 2, lines 35-62, column 5, line 65 - column 6, line 18, and column 6, lines 46-51);*

*transferring the selected audio data file and the associated decoder file to the digital signal processor, wherein the selected audio data file and the associated decoder file are both stored in a single removable data storage device coupled to the handheld audio playback device (column 6, lines 11-33);*

*using a security code associated with the handheld audio playback device to generate a decryption program;*

*decrypting the associated decoder file using the decryption program;*

*decrypting the selected audio data file using the decryption program;*

*decoding the selected audio data file in accordance with the decoder file in the digital signal processor (column 6, lines 18-30); and*

*providing the decoded audio data file to an output device (column 5, lines 31-36).*

Kaganas teaches a unique identification associated with a single removable data storage device. They teach decoder files, or programs, associated with different music

(column 6, lines 11-18, and lines 46-51) and determining a unique identification associated with the removable data storage device coupled to the handheld audio playback device (column 4, lines 55-60). However, they do not teach the steps of generating a decryption program using a security code and decrypting the associated decoder and audio files using a generated decryption program.

Cho teaches an encryption method for protecting copyrighted audio files (abstract and figures 1-3). Specifically, Cho teaches decrypting the audio file using a decryption algorithm or program (see column 5, lines 54-57). It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Kaganas and Cho for the purpose of protecting data files in transit from a host computer to a client computer (column 2, lines 30-40). However, neither Kaganas nor Cho teach encrypting or decrypting the associated decoder and decryption program.

Truong teaches a system for controlling access to information (column 1, lines 59-63). The teachings include securing a recording medium (Kaganas teaches a memory card, or MMC card) using a unique identification (Truong, column 3, lines 22-32), which as shown above is similar to the unique identification used to encrypt the audio (Cho teaches encrypting and decrypting audio using a unique id, column 4, lines 22-40). The recording medium contains data (Kaganas teaches an audio data file) and/or applications (Kaganas teaches programs, or decoder files and Cho also teaches programs, or decoders and algorithms), and decoding these from encrypted form (Truong, column 3, lines 10-16 and line 26). Truong teaches that the security table, which includes various decoding algorithms, is used to create the encoded information

(Truong, column 3, line 26 and lines 34-36). The decoding utilizes the unique identification specific to the recording medium to decode the data (Truong, column 4, lines 24-58). The unique encrypted signature is based on information on the recorded medium (Truong, column 4, lines 44-45) and the keys associated with decrypting the associated data and programs are also based on values found in a security table (Truong, column 3, lines 25-26 and lines 34-36). This reads on "*using a security code associated with the handheld audio playback device to generate a decryption program*", wherein the unique identification, as taught by Cho, is associated with a storage medium to create an encrypted signature (Cho, column 4, lines 10-21). Furthermore it would have been obvious at the time by one of ordinary skill to encrypt the algorithm and decoder files to protect copyrights (implied that the various keys are used to encode/decode the various data and/or applications; see Truong, column 3, lines 13-16 and column 4, lines 6-10). It would have been obvious for one of ordinary skill in the art to combine the teachings of Kaganas, Cho, and Truong for the purpose of copy protection (Truong, column 1, lines 9-12). One of ordinary skill in the art at the time of the invention can appreciate that the protection of decoding programs and audio data files is more secure when different keys are used to protect the programs and files individually.

Regarding **claim 2**, the further limitation of claim 1, see Kaganas

*... further comprising the step of reading a configuration file that associates each one of a plurality of audio data files with a particular one of a plurality of decoder files, and the identifying the decoder file step comprises identifying the decoder file using the configuration file.*

Kaganas teaches the use of a plurality of codecs, and it is inherent that a codec is associated with a file format. Kaganas also teaches the use of an operating system for

a plurality of uses, wherein they teach the use of Windows 95® when discussing e-mail and other communication features (column 3, lines 28-34). Popular operating systems maintain a list of programs associated with file types, such as ASCII text files. It is inherent that an operating system used for playback on the system of Kaganas maintains a configuration file regarding the association of codecs and audio data files.

Regarding **claim 3**, the further limitation of claim 2, see Kaganas

*... wherein the removable data storage device is a solid state data storage device.* (column 7, lines 44-52)

Kaganas teaches the use of solid state removable media.

Regarding **claim 4**, see the preceding argument with respect to claim 1.

Kaganas teaches a user input means (figure 1, unit 44), data input means (figure 1, unit 37), a digital signal processor (figure 1, unit 31), and a micro-controller with these features (figure 1, unit 32 and column 2, lines 10-13). The combination of Kaganas, Cho, and Truong teach the amended features.

Regarding **claim 5**, the further limitation of claim 4, see the preceding argument with respect to claim 3. Kaganas teaches the use of a solid-state data storage device that is removable.

Regarding **claim 6**, see the preceding argument with respect to claims 4 and 5. The combination of Kaganas, Cho, and Truong teaches a portable audio playback system with these features.

Regarding **claim 7**, the further limitation of claim 6, see the preceding argument with respect to claim 5. Kaganas teaches a removable solid-state storage device.



Regarding **claim 9**, see the preceding argument with respect to claim 2. Kaganas inherently teaches the use of configuration files with codec-file associations.

Regarding **claim 10**, see the preceding argument with respect to claim 1. The combination of Kaganas, Cho, and Truong teach these features.

### **(10) Response to Argument**

#### **A. Patentability of Claims 1-7 and 9-10 under 35 U.S.C. §112, First Paragraph**

The examiner respectfully disagrees. The step of "using a security code associated with the handheld audio playback device to generate a decryption program" as recited by claim 1 is not enabled by the appellant's specification. The specification does not appear to contain a written description of this aspect of the invention using clear, concise, and exact terms so as to enable any person skilled in the art to which it pertains. There is no recitation, except for the claim language, of generating a decryption program.

In a response to the final rejection mailed 10/31/2008, the appellant argued that the "generating step" may be performed by decrypting. This argument appears to the examiner to point towards the currently held opinion that the "generating step" is broader than a mere "decrypting step". The specification supports decrypting, but does not appear to enable one of ordinary skill in the art an appreciation of the broader aspects of generating a program. The examiner believes that generating can have

many more meanings than a decryption with respect to a computer program or algorithm.

The appellant argues that a decrypting "inherently generates" a decryption program. The examiner does not believe this statement to enable a "generating step" because the specification does not disclose generating with respect to the decryption program. The specification discloses "encoding audio data... to generate encoded audio" from page 3, line 32 to page 4, line 1. Next, with respect to generating, the specification discloses "A second key... and the unique ID number... are used to generate a final key...." on page 9, line 9 to line 12. The final key generation is also disclosed on page 9, line 15 to line 17, wherein there is still no disclosure of a decrypting step generating a decryption program. On page 10, from line 16 to line 19, the specification discloses "Various encryption and decryption methods known to those skilled in the art for generating an encrypted file using a selected key, and then decrypting the encrypted file using the selected key may be used." Also on page 10, the specification discloses using a key that is generated and the generation of a configuration file and file attributes. Finally, the paragraph on page 11, from line 10 to line 21, discloses "[a] security code in block 50 is used to decrypt the decryption program in block 52." The paragraph also discloses the generation of a final key, but does not teach that decryption is performed by generating or generation.

A generating step, as shown with respect to the disclosure, appears to be more than decryption. The examiner does not contend that decryption may inherently generate a decryption program, because it is believed that the claim language cannot

be interpreted in that fashion. It should be argued that generating inherently decrypts a decryption program, but that argument cannot be reasonably made. Inherency cannot be established with a certain result or characteristic that may occur. Above, it has been pointed out that the applicant has argued that a generating step may be performed by decryption. This appears to be an admission that there is no inherency with respect to decryption being performed in a generating step. There may be many paths to generating a decryption program, but the specification does not appear to enable more than a decryption step.

**B. Patentability of Claims 1-7 and 9-10 under 35 U.S.C. §112, Second Paragraph**

The examiner respectfully disagrees for similar reasons as discussed above. The decryption may inherently generate a decryption program, but the claim language would indicate that a generating step of a decryption program must inherently decrypt an encoded decryption program. The examiner does not believe that a generating step inherently decrypts, and that the claim language is indefinite with respect to the disclosed invention.

**C. Patentability of Claims 1-7 and 9-10 under 35 U.S.C. §103(a)**

The examiner respectfully disagrees. In the combination Cho, specifically, teaches a security code associated with a unique identification of a handheld audio device (see Cho, column 5, lines 58-61). All three of the references, Kaganas, Cho, and Truong, teach unique identification means associated with the handheld audio device. Kaganas teaches a unique identification with respect to a memory card (see

Kaganas, column 4, lines 55-60). Cho teaches a unique identification for creating a security code, or key, used to encrypt and decrypt a music file on memory card (see Cho, column 5, lines 54-61). Truong also teaches a unique identification associated with a recording medium (see Truong, column 3, lines 22-26). In a combination it would have been obvious by one of ordinary skill in the art at the time of the invention to utilize a security code, as taught by Cho, with the methods taught by the other two references. It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Kaganas, Cho, and Truong for the purpose of enhanced copy protection. One of ordinary skill in the art would have been interested in copy protection for at least protecting the creative works embodied by the audio file, or music, as taught by Cho. One of ordinary skill in the art also would have been interested in enhancing copy protection for protecting the creative works embodied by the associated programs, or decryption and decoding algorithms, necessary to decrypt and decode any audio file.

Neither Kaganas nor Cho teach "using a security code associated with the handheld audio playback device to generate [(i.e. decrypt)] a decryption program". However, as pointed out above, the combination of Kaganas, Cho, and Truong teach encrypted audio files and encrypted applications (see Truong, column 3, lines 10-26). Cho teaches a security code, or key, associated with the audio playback device to decrypt an audio file, and it is the combination that makes obvious the use of a security code associated with the handheld audio playback device to be used to decrypt associated applications. In the combination, Kaganas teaches associated applications,

such as decoder files and enabling software on a memory card (see Kaganas, column 2, lines 59-63). It would have been obvious for one of ordinary skill in the art at the time of the invention that associated applications and enabling software can be a decryption program to be used to decrypt the decoder file and the audio file to be decoded with the decoder file (see Cho, column 5, line 58 - column 6, line 2, wherein Cho teaches that layered encryption is useful for greater protection).

The examiner disagrees that impermissible hindsight has been used in the combination. As stated above, the combination of Kaganas and Cho protect the audio file through encryption, and Cho appears to state that a layered encryption scheme is better for protection, wherein a layered encryption is embodied by an encrypted encryption key. The examiner believes that the combination of Kaganas, Cho, and Truong makes obvious the further protection of applications, such as algorithms. The motivation to combine all three references is similar to combine the first two, but all three references in combination provide better protection. It would have been obvious for one of ordinary skill in the art at the time of the invention to combine for the purpose of protecting not only the audio file, but also protecting the programs used in decrypting and decoding the audio file.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2614

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Daniel R. Sellers/  
Examiner, Art Unit 2614

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